

REMARKS

Upon entry of this Amendment, claims 1-7, 9-15, and 17 will remain pending and under examination.

In the Office Action,¹ the Examiner rejected claims 3, 6, 11, and 14 under 35 U.S.C. § 112, first paragraph; rejected claims 1-7, 9-15, and 17 under 35 U.S.C. § 112, first paragraph; rejected claims 1-7, 9-15, and 17 under 35 U.S.C. § 112, second paragraph; and rejected claims 1-7, 9-15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,463,659 to Nealon et al. ("*Nealon*") in view of U.S. Patent No. 6,148,205 to Cotton ("*Cotton*"), and further in view of a document titled LIST OF NEW INSPECTION EQUIPMENT AND REVISED SPECIFICATIONS FOR APPROVED INSPECTION EQUIPMENT ("*Executive Council*").

Applicants thank the Examiner for careful examination of this application. Applicants respectfully traverse the Examiner's rejections for the following reasons.

I. Rejection of claims 3, 6, 11, and 14 under 35 U.S.C. § 112, first paragraph

Applicants respectfully traverse the Examiner's rejection of claims 3, 6, 11, and 14 under 35 U.S.C. § 112, first paragraph. The Examiner asserts that claims 3, 6, 11, and 14 fail "to comply with the enablement requirement," stating "claims [3 and 11] disclose that the transmission output is **only** reduced in a particular one of said radio devices," and "claims 1 and 9 have been amended to disclose that the coverage area of **both** portable devices is reduced" (emphasis in original, Office Action at p. 2). The

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Examiner asserts that “[t]hus claims 3 and 11 are logically inconsistent with amended claims 1 and 9” (Office Action at p. 2).

Claims 1 and 9 recite “switching coverage area of two or more of said portable radio devices ..., the second coverage area being smaller than the first coverage area,” (emphasis added). A “coverage area,” as recited by claims 1 and 9, may be defined by an area of transmission output and an area of reception sensitivity. Therefore, while claim 1 recites switching of the portable radio devices to a smaller “coverage area,” this may be accomplished by reduction of the transmission output, reduction of the reception sensitivity, or a combination of both. Accordingly, claim 3, which recites “wherein the transmission output is reduced only in a particular one of said portable radio devices,” is consistent with claim 1, because a first radio device may alter a “coverage area” by reduction of transmission output (claims 3 and 11), while a second radio device may alter a “coverage area” by reduction of reception sensitivity (claims 6 and 14).

Applicants refer the Examiner to, for example, the paragraph bridging pp. 14-15 of Applicants’ specification.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 3, 6, 11, and 15 under 35 U.S.C. § 112, first paragraph.

II. Rejection of claims 1-7, 9-15, and 17 under 35 U.S.C. § 112, first paragraph

Applicants respectfully traverse the rejection of claims 1-7, 9-15, and 17 under 35 U.S.C. § 112, first paragraph. The Examiner asserts that these claims fail “to comply with the written description requirement” because the “Examiner does not find the following limitation in the disclosure: ‘specifying other devices to be mutually

authenticated when the two or more portable radio devices are within predetermined range of each other over said second coverage area” (Office Action at p. 2).

Applicants direct the Examiner’s attention to, for example, the abstract, page 9, lines 5-9, and page 8, line 6 of Applicants’ specification. The abstract describes that a plurality of radio devices may be mutually authenticated, and page 9, lines 5-9 describes that “when coverage areas of radio waves transmitted from the terminal from the terminal devices come into an overlapped relation ... mutual authentication is enabled to start.” Mutual authentication may be executed using, for example, authenticating unit 120 (Figure 1), which can perform an analysis to make authentication (page 8, line 6). Performing an analysis and specifying other devices to be authenticated within a range of each other may be performed using transmitters and receivers to identify and authenticate other devices, as described throughout the specification.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-7, 9-15, and 17 under 35 U.S.C. § 112, first paragraph.

III. Rejection of claims 1-7, 9-15, and 17 under 35 U.S.C. § 112, second paragraph

Applicants respectfully traverse the rejection of claims 1-7, 9-15, and 17 under 35 U.S.C. § 112, second paragraph. The Examiner asserts that “[i]t is unclear whether the phrase ‘before authentication initiates’ refers to narrowing the coverage area or the mutual authentication” (Office Action at p. 3). Applicants respectfully disagree with the Examiner’s assertion. Nevertheless, in an effort to expedite prosecution, Applicants amend claims 1, 9, and 17 to clarify that “narrowing [of] the coverage area” is performed

before mutual authentication. Support for this amendment may be found at, for example, page 14 of Applicants' specification.

IV. Rejection of claims 1-7, 9-15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Nealon* in view of *Cotton*, and further in view of *Executive Council*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-7, 9-15, and 17 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, none of *Nealon*, *Cotton*, or *Executive Council*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Claim 1, for example, recites a combination including "performing mutual authentication between two or more portable radio devices by said authenticating means automatically when the coverage area of the two or more portable radio devices overlap" (emphasis added). The Examiner asserts that *Nealon* teaches this element in

col. 9, lines 3-25² and that *Cotton* teaches this element in col. 5, lines 25-31 (Office Action at p. 4).

The cited portion of *Nealon* teaches away from this claimed step. *Nealon* teaches “the user presses the # button ... to prepare the handset unit to enter registration” (*Nealon*, col. 9, lines 3-5). Requiring a user to press a button, as taught by *Nealon*, does not constitute a teaching or suggestion of “performing mutual authentication ... automatically when the coverage area of the two or more portable radio devices overlap,” as recited by claim 1.

Further, the cited portion of *Cotton* teaches sending a “registration request message 708 to the base station” and that “[t]he base station 706 responds to the registration request message 708 with a registration response message 712” (*Cotton*, col. 5, lines 25-31). However, such teachings by *Cotton* do not constitute a teaching or suggestion of “performing mutual authentication ... automatically when the coverage area of the two or more portable radio devices overlap,” as recited by claim 1.

Claim 1 also recites a combination including, for example, “preventing communication with an unintentional portable radio device by narrowing the coverage area of the two or more portable radio devices to be mutually authenticated before mutual authentication initiates based on the proximity of the two or more portable radio devices” (emphasis added). The Examiner asserts that *Nealon* teaches this claimed step in col. 8, lines 23-34 (Office Action at p. 4).

² The Examiner also concedes that *Nealon* fails to teach this element (Office Action at p. 4). However, this concession appears to be only related to the element of “mutual authentication.”

The cited portion of *Nealon* discloses “[t]o initiate the registration process, a user presses and holds the registration switch,” and that “[w]hile the base unit 10 is in the registration state, the cordless telephone station (i.e., both the base unit and handset unit) is operating at a low power level below the normal operating power level and no calls can be placed or received from this station” (*Nealon*, col. 8, lines 24-34). Pressing a button to initiate registration, and then lowering the power level, as taught by *Nealon*, does not constitute a teaching or suggestion of “preventing communication with an unintentional portable radio device ... based on the proximity of the two or more portable radio devices,” as recited by claim 1.

Executive Council fails to cure the deficiencies of *Nealon* and *Cotton*, nor does the Examiner rely on *Executive Council* for such teachings. Accordingly, because none of *Nealon*, *Cotton*, or *Executive Council* teaches or suggests each and every element recited by claim 1, no *prima facie* case of obviousness has been established for this claim. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Moreover, *Nealon*’s requiring a user to press a button teaches away from “automatically” performing mutual authentication, as well as “preventing communication ... based on the proximity of the two or more portable radio devices,” as recited by claim 1. M.P.E.P. § 2145 instructs that “[i]t is improper to combine references where the references teach away from their combination.” Because *Nealon* teaches away from the proposed combination, the Examiner’s proposed combination of references is improper. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

The Examiner also has not shown any motivation in the cited references to modify *Nealon* with *Cotton*, and further with *Executive Council* to produce the claimed invention. None of *Nealon*, *Cotton*, or *Executive Council* teaches or suggests motivation to insert “performing mutual authentication ... automatically when the coverage area of the two or more portable radio devices overlap,” or to prevent “communication with an unintentional portable radio device ... based on the proximity of the two or more portable radio devices,” as recited by claim 1. Therefore, one of ordinary skill in the art would not turn to *Nealon*, *Cotton*, or *Executive Council* to develop at least this aspect of Applicants’ claimed invention. For at least this additional reason, no *prima facie* case of obviousness has been established.

In addition, the Examiner has not established a publication date for *Executive Council*. While the document has dates of “2-5 February 1999” and “25 January 1999,” neither of these dates indicate a publication date.

Independent claims 9 and 17, although of different scope, recite similar elements to independent claim 1. Claims 2-7 and 10-15 depend from independent claims 1 and 9 and therefore include all of the elements recited therein. Accordingly, for at least the reasons discussed above with respect to claim 1, no *prima facie* case of obviousness has been established with respect to claims 2-7, 9-15, and 17.

Further, dependent claims 3 and 11 recite “wherein the transmission output is reduced only in a particular one of said portable radio devices” (emphasis added). The Examiner asserts that *Nealon* teaches this element in column 8, lines 23-34 (Office Action at p. 5). However, the cited portion of *Nealon* teaches that “both the base unit and handset unit ... operat[e] at a low power level” (*Nealon*, col. 8, lines 31-32, see also

Nealon, col. 7, lines 19-21). Reduction of the power level in both the base unit and the handset, as taught by *Nealon*, does not constitute a teaching or suggestion of reducing output “only in a particular one of said portable radio devices,” as recited by claims 3 and 11. *Cotton* and *Executive Council* fail to cure the deficiencies of *Nealon*, nor does the Examiner rely on *Cotton* or *Executive Council* for such teachings. For at least this additional reason, no *prima facie* case of obviousness has been established for claims 3 and 11.

Further, dependent claim 6 and 14 recite “wherein the reception sensitivity is reduced only in a particular one of said portable radio devices” (emphasis added). The Examiner asserts that *Nealon* teaches this element in column 8, lines 23-34 (Office Action at p. 6). However, the cited portion of *Nealon* does not teach or suggest reduction of a “reception sensitivity.” Rather, *Nealon* only teaches reduction of a “transmitted power level” (*Nealon*, col. 7, lines 19-21). Moreover, *Nealon* does not teach or suggest altering power in a only “a particular one of said portable radio devices,” as discussed above regarding claim 3. Reduction of the transmission power level in both the base unit and the handset, as taught by *Nealon*, does not constitute a teaching or suggestion of reducing the reception sensitivity “in a particular one of said portable radio devices,” as recited by claims 6 and 14. *Cotton* and *Executive Council* fail to cure the deficiencies of *Nealon*, nor does the Examiner rely on *Cotton* or *Executive Council* for such teachings. For at least this additional reason, no *prima facie* case of obviousness has been established for claims 6 and 14.

Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-7, 9-15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Nealon*, in view of *Cotton*, and further in view of *Executive Summary*.

V. Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

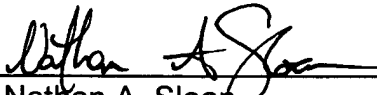
Applicants respectfully request that the Examiner respond to every point raised herein in accordance with M.P.E.P. § 707.07(f). Should the Examiner continue to dispute the patentability of the claims after consideration of this Reply, Applicants encourage the Examiner to contact Applicants' undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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